REMARKS

Objection to the Specification

The Examiner has objected to the amendment filed on February 10, 2009 under 35 U.S.C. § 132(a) as introducing new matter, specifically, the phrase "an on demand remote inventory management of said vending device." Applicant respectfully requests that this rejection be withdrawn because the specification as originally filed includes adequate support for "an on demand remote inventory management of said vending device," and therefore, the phrase cannot be considered new matter.

For example, paragraph 7 of the original application adequately discloses the on demand remote inventory management of the vending device:

> "a method of distributing hair care or cosmetic products on demand, . . . including the steps of installing a vending device and logical system which electronically transmits inventory data to a central database thus ensuring efficient restocking . . . ; . . . transmitting the transaction data to a central computer over a communications network; updating inventory data of the vending device based on the transaction data; and scheduling restocking to the vending device based on the updated inventory data . . . ." *See* Specification ¶ 7 (emphasis added); *see also* Specification ¶ 11.

Furthermore, paragraph 26 of the original application adequately discloses the on demand remote inventory management of the vending device:

> "After the hair care product is dispensed to the salon owner or stylist, the vending device 100 transmits the transaction data, such as product sku number, location of the vending device, etc., to the central computer 300 over the communications network 310 in step 460. Upon receipt of the transaction data, the central computer 300 updates the inventory data of the vending 100 in step 470 and if necessary, delivery to the vending device (i.e., the associated hair or beauty salon) is automatically scheduled for restocking in step 480."

See Specification ¶ 26 (emphasis added).

Clearly these passages describe an "on demand remote inventory management of the vending device," and as such, the phrase cannot constitute new matter. "Mere rephrasing of a passage does not constitute new matter." MPEP § 2163.07. Therefore, as the phrase is

adequately supported by the original specification, Applicant respectfully requests that the Examiner's objection to the specification under 35 U.S.C. § 132(a) be withdrawn.

Status of the Claims

Claims 1, 3-8, 10-13, 15-20, 22-27, 29-34, 36-39, 41-46, 48-51 are currently pending.

Claims 1, 3-8, 10-13, 15-20, 22-27, 29-34, 36-39, 41-46, 48-51 stand rejected.

In light of the remarks to follow, reconsideration and allowance of this application are requested.

112 Rejection

Claims 1, 8, 12, 19, 27, 34, 27, and 45 are rejected under 35 U.S.C. § 112, ¶ 1, as unenabled. Specifically, the Examiner contends that the specification does not enable "providing on demand remote inventory management of said vending device." Applicant respectfully requests that this rejection be withdrawn because the specification as originally filed "describes the invention in such terms that one skilled in the art can make and use the claimed invention" without undue experimentation; therefore, the claims are enabled. MPEP §§ 2164, 2164.01. The test of enablement "is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue." MPEP § 2164.01 citing *In re Angstadt*, 537 F.2d 498, 504 (C.C.P.A. 1976). Moreover, it is well know that "a patent need not teach, and preferably omits, what is well known in the art." MPEP § 2164.01 citing *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991).

Paragraphs 7, 11, and 26 of the original application clearly enable "providing on demand remote inventory management of the vending device":

> "After the hair care product is dispensed to the salon owner or stylist, the vending device 100 transmits the transaction data, such as product sku number, location of the vending device, etc., to the central computer 300 over the communications network 310 in step 460. Upon receipt of the transaction data, the central computer 300 updates the inventory data of the vending 100 in step 470 and if necessary, delivery to the vending device (i.e., the associated hair or beauty salon) is automatically scheduled for restocking in step 480." *See* Specification ¶ 26 (emphasis added).

> "[A] method of distributing hair care or cosmetic products on demand, . . . including the steps of installing a vending device and logical system which electronically transmits inventory data to a central database thus ensuring efficient restocking . . . ; . . . transmitting the transaction data to a central computer over a communications network; updating inventory data of the vending device based on the transaction data; and scheduling restocking to the vending device based on the updated inventory data . . . ." *See* Specification ¶ 7 (emphasis added); *see also* Specification ¶ 11.

Clearly these passages enable one of ordinary skill to make and use the invention commensurate in scope with claims 1, 8, 12, 19, 27, 34, 37 and 56, particularly providing on demand remote inventory management of the vending devices. Therefore, Applicant respectfully requests that the Examiner's rejection to of claims 1, 8, 12, 19, 27, 34, 37, and 56 under 35 U.S.C. § 112, ¶1 be withdrawn.

103 Rejection

Claims 1, 3-8, 10-13, 15-20, 22-27, 29-34, 36-39, 41-46, 48-51 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,163,010 to Klein et al. (hereafter "Klein") in further view of U.S. Patent No. 4,767,917 (hereafter "Ushikubo") and in further view of U.S. Patent No. 7,099,740 to Bartholomew et al. (hereafter "Bartholomew"). Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not be based on the Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. Here, the Examiner has failed to establish a *prima facie* case of obviousness because the combination of Klein, Ushikubo, and Bartholomew does not teach or suggest all the claim limitations of independent claims 1, 3-8, 10-13, 15-20, 22-27, 29-34, 36-39, 41-46, 48-51.

As further explained in Applicant's February 10, 2009 and September 11, 2008 responses, only the present invention teaches or suggests on demand remote inventory management of a hair care or cosmetic vending apparatus and scheduling delivery to the vending apparatus based on the remote inventory management, thereby eliminating the responsibility and cost associated with maintaining and managing inventory of hair care/cosmetic products. Contrary to the Examiner's assertions, none of the asserted references alone or in combination teach this limitation of all the pending claims.

Specifically, Klein at best is directed to a singular machine that prepares cosmetic products and is in no way concerned with the remote central management of the inventories of any number of cosmetic vending devices in any number of disparate locations as contemplated by the present invention. Even the portion cited by the Examiner in the Final Office Action at pages 2 and 6, states that Klein is directed to "*a device* for formulating a cosmetic product . . at the point of sale," meaning a singular device at a specific location.

Ushikubo solely is directed to an automatic vending machine where pre-registered key cards are used for effecting purchases and where all components of the system are located in the same store. *See, e.g.*, Ushikubo, col. 2, lns. 45-46; col. 6, ln. 52 – col. 7, ln. 11. Ushikubo is in no way concerned with the remote central management of the inventories of any number of cosmetic vending devices in any number of disparate locations as contemplated by the present invention. In fact, the portion of Ushikubo cited by the Examiner in the Final Office Action at pages 2 and 6 is simply not concerned with the management of inventory for a particular device, but instead, indicates that for every specific transaction, the vending device prints out a list of the goods which have been sold for that particular transaction, and that the list is also kept within the vending device to be print out at a later time for the purpose of being "used for charging the account of the card holder." *See,* Ushikubo, col. 5, lns. 22 – 51 (emphasis added). Nowhere does Ushikubo indicate that the list is kept for purposes of inventory or that the list is retained for any period of time beyond a particular transaction to make it viable for any other purpose than the particular transaction to which it relates.

Bartholomew is merely directed to a nail polish dispenser that allows for nail polish formulations to be created according to a customer's specifications at the point-of-sale ("POS"). *See, e.g.*, Bartholomew, col. 3, 32-39. Bartholomew does not teach or suggest on demand remote inventory management of vending devices and scheduling delivery to those vending devices with low inventories based on the on demand remote inventory management of the claimed invention. In fact, column 6, lines 44-67 to column 7, lines 1-2 in Bartholomew, cited by the Examiner, do not disclose compiling data for the purpose of managing the inventory of various vending devices when an actual purchase is made on a specific vending device and also scheduling a delivery of the required product to a specific vending device identified by the claimed invention. To the contrary, Bartholomew merely describes compiling data "for evaluating demographic correlations, as to consumer color preference data . . ." for purposes of studying overall demographic preferences. It is appreciated that one of ordinary skill in the art would not confuse Bartholomew's demographic study based on user preference with the claimed invention's on demand remote inventory management based on actual sales and transactions.

Moreover, Bartholomew is concerned with a system residing in the vending machine itself for monitoring its own inventory levels. Contrary to the Examiner's assertion, Bartholomew does not teach or suggest managing the inventories of vending devices remotely from a central location and automatically scheduling a delivery to a particular vending device if the inventory of that particular vending device is low. That is, Bartholomew does not teach or suggest managing inventories of vending devices remotely from a central location and in fact, does nothing itself to actually manage the restocking of any depleted fluids. Even col. 11, lines 20-43, cited by the Examiner, shows that the apparatus must either "notify the operator" or "notify a remote subscriber" of a reduction in product. The claimed invention, on the other hand, removes the need for any operator or remote subscriber involvement, by remotely managing a plurality of vending devices that might be in a number of disparate locations from the central location.

"To imbue one of ordinary skill in the art with knowledge of the present invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim of the insidious effect of hindsight syndrome, wherein that which only the inventor taught is used

against the teacher." W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). The prior must to be judged based on a full and fair consideration of what that art teaches, not by using Applicant's invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct Applicant's invention. The Examiner cannot simply change the principle of the operation of the reference or render the reference inoperable for its intended purpose to render the claims unpatentable. Nowhere do any of the cited references teach or suggest on demand remote inventory management of vending devices in disparate locations from a central location and scheduling delivery of the products to a specific vending device identified by the claimed remote inventory management as having low inventory. Accordingly, it is submitted that the Examiner has succumbed to the lure of prohibited hindsight reconstruction.

Moreover, the present invention solves a problem that was simply not at issue in any of the cited references, namely how to remotely manage the product inventory of the vending devices in many locations and schedule delivery only to those vending devices having low inventories. It is undeniable that none of the cited references individually or in combination therewith are remotely concerned with the problem of on demand remote inventory management of the vending device and scheduling delivery of the products to the vending device based on the remote inventory management. Since Applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by the cited prior art, the basis for patentability of the claims is established. See *In re Wright*, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner's rejection. "The problem solved by the invention is always relevant". *Id.* at 1962. See also, *In re Rinehart*, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Further, Applicant herein incorporates by reference in their entireties all the arguments made in its February 10, 2009 and September 11, 2008 responses, with respect to Klein, Ushikubo, and Bartholomew. The Examiner cannot simply change the principle of the operation of the references or render the references inoperable for their intended purposes to render the

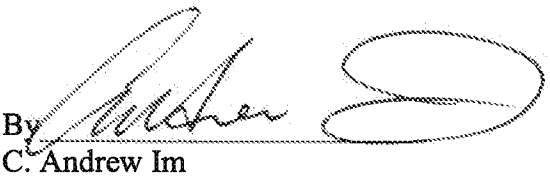
claims unpatentable. Even if one of ordinary skill in the art combines Klein and Ushikubo with Bartholomew, as suggested by the Examiner, there is no reasonable expectation of success because the resulting combination will not result in the present invention. None of the cited references teach or suggest on demand remote inventory management of the vending device and scheduling delivery of products to the vending device based on the remote inventory management. Therefore, the Examiner has again failed to establish a *prima facie* case of obviousness because there is no reasonable expectation of success in combining Klein and Ushikubo with Bartholomew because the resulting combination will not result in the present invention.

In view of the above, Applicant believes that the pending application is in condition for allowance and requests that the Examiner's rejections be reconsidered and withdrawn.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. **NY-WELLA-204-US** (10207602) from which the undersigned is authorized to draw.

Dated: June 1, 2009

Respectfully submitted,



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